

REMARKS

By this response, claims 1-18 are pending. Claim 9 is amended while all others remain as originally presented. Substantively, all claims stand rejected as unpatentable over Yajima (U.S. 6,240,264) in view of Dunlap (U.S. 2002/0181013).

According to the Examiner, the claims are rejected because it would be obvious to “switch the recording speed between a low and a high speed in the device of Yajima et al. based on the determined number of pages of the print job as taught by Dunlap.” 3-23-06 *Office Action*, ¶ *bridging pages 3 and 4*. Further, the motivation for doing so relates to “efficiently speed[ing] the recording of the image for high volume print jobs.” 3-23-06 *Office Action*, 1st ¶, p. 4, l. 3. The Applicant does not dispute that Yajima teaches high and low speed recording (especially according to ordering various print jobs in a monochrome- and color-capable copying machine) and that Dunlap teaches determining the number of pages of a print job for a printer. The Applicant does dispute, however: (1) that the references are properly combinable; and (2) that, even if combined, render the invention obvious.

For instance, Dunlap teaches “selecting a printer from a plurality of printers to fulfill a print job of a user” and does so according to a comparison between “a print request for the print job with the print capabilities of the printers.” *Abstract*. In turn, details of the print capabilities 28 of the printers are representatively itemized in Figure 3. Among other things, printing speed and printer queue attributes 288 and 289 are identified. At ¶ [0031],

[e]xamples of different printing speeds include, for example, 17 pages per minute, 24 pages per minute, and 32 pages per minute. Printer queue attribute 289 identifies, for example, a wait time for printing at printer 16 and an order of printing at printer 16.

Thus, Dunlap intrinsically contemplates differing speeds and inherent delays of various printers to match print jobs to the best available printer. Dunlap never mentions, however, operating printing at a various speed in a given printer based on a number of sheets to be printed, as the instant invention requires. In other words, both the instant invention and Dunlap disclose various print speeds, numbers of sheets per print job, and time to first print, but only the instant invention remedies the problem by printing at different speeds in a single printer based on print job size. In still other words, the present invention cannot now be said to be obvious to skilled artisans in view of Dunlap when Dunlap identifies all the variables of the instant invention, but not the claimed remedy to the problem.

Regarding Dunlap and Yajima together, no motivation for the combination exists.¹ That is, Yajima teaches methodology for determining the order of print jobs in a single digital copying machine. *Abstract*. To the extent a copying machine is arguably a printer, Yajima still only teaches a single printer. Dunlap, on the other hand, concerns itself with cadres of printers so that a best printer of the many can be identified to match to a specific print job. Dunlap has also already identified Yajima's capability of "an order of printing at printer 16." ¶ [0031]. So, Dunlap's teaching would require no further looking into another patent relating to print job order. The combination is rendered superfluous.

Moreover, Yajima's technology as a copying machine varies vastly from printers with regard to job sizes. That is, Yajima exactly knows the number of papers in a copying job because of the number of sheets fed to it from the paper feeder mechanism, e.g., 112.

¹As is well established, "virtually all [inventions] are combinations of old elements." *Ruiz v. A.B. Chance Co.*, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). Also, an obvious determination under 35 U.S.C. 103(a) requires an "as a whole" analysis of the prior art to otherwise prevent an impermissible "evaluation of the invention part by part." *Id.* For otherwise, "an obviousness assessment might break an invention into its component parts (A+B+C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious." *Id.* In turn, "this form of hindsight reasoning, using the invention as a roadmap to find its prior components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention." *Id.*

Alternatively, Yajima knows the number of papers in a copying job because users utilize single copies by placing single papers directly on the document platen, e.g., 111. Thus, Yajima always knows the job size and never needs to determine it, much less coordinate it to printing speeds. Instead, Yajima's different recording speeds "are different depending on a color image and a monochrome image" (*col. 9, ll. 7-8*), not job size. The Examiner is correct for noting this and stating that "Yajima et al. fails to teach the switch from the low or intermediate speed recording to the high-speed recording based on the determined number of sheets to be printed." *3-23-06 Office Action, 5th ¶, p. 3*. What is to be appreciated, however, is that Yajima would never concern itself with adjusting recording speed based on print job size. The combination with Dunlap then, who determines job size, thusly, fails.

Additionally, the Examiner suggests a reason for combining Dunlap with Yajima. Namely, to "efficiently speed the recording of the image for high volume print jobs." *3-23-06 Office Action, 1st ¶, p. 4, l. 3* However, Dunlap was squarely faced with the Examiner's recited motivation of speeding up print jobs. Dunlap's solution, however, was that of marrying print jobs to a best suited printer in a cadre of printers. It was never to adjust various capabilities within a single printer, much less adjusting capabilities within a single printer based on a number of sheets in a given print job. Yajima was also squarely faced with the Examiner's cited motivation of speeding up print jobs. Yajima's solution, however, was that of adjusting recording speed as a function of monochrome or color printing. It was never to determine the number of sheets of a print jobs and then operate an imaging device at various speeds based on the number of sheets. How then can two references who were already faced with the problem of needing to speed up print jobs, and who offered two completely different solutions, now be said to render obvious the instant invention, faced with the same problem, who offers still another solution? It is respectfully submitted that they cannot and the claims are not obvious variations of the prior art.

As is longstanding precedent, Examiner's cannot determine obviousness by selectively culling bits and pieces from various prior art references to fit the parameters of the invention. Rather,

there must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

Also, inventions,

once disclosed, seems obvious and simple. But that is the nature of most important creative ideas. Once we know of them, it seems as if we must always have done so. Science endeavors to move in the direction of simplicity. (Ptolemy had his Newton; and Newton, his Einstein. We increase knowledge importantly, so to speak, by shaving old ideas with Occam's razor.)" Frank, J., concurring in *Picard v. United Aircraft Corp.*, 128 F.2d 632, 638, 53 USPQ 563, 568 (2d Cir. 1942).

Administratively, the Applicant has amended claim 9 to point out "the end of printing," instead of the erroneously stated "the end or printing." For claims 5-8, the Applicant can, indeed, present claims with the recited "and" between the two default statuses of the printer. For instance, Figure 4 teaches a first default status of an intermediate print speed (e.g., "NO" route for decision 252). For print jobs with an undetermined size (e.g., "NO" route for decision 254), however, a second default status may now be set to high speed at 260. It may also remain at the intermediate speed. Nowhere does Yajima or Dunlap teach

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this. Reconsideration is requested. Claims 13-16 that depend from 5-8 are also submitted as allowable

For at least these reasons, the Applicant submits that all claims are in a condition for allowance and requests a timely Notice of Allowance be issued for same. ***To the extent any fees are due, although none are believed due, the undersigned authorizes their deduction from Deposit Account No. 11-0978.*** If any other matters require attention, please have the Examiner contact the undersigned representative.

Respectfully submitted,

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